



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,025	09/02/2003	Jerry C. Nims	011908.0102	1556
41434 7590 11/17/2008				
PATTON BOGGS LLP				
2550 M STREET NW				
WASHINGTON, DC 20037-1350				
EXAMINER				
KOZIOŁ, STEPHEN R				
ART UNIT		PAPER NUMBER		
2624				
MAIL DATE		DELIVERY MODE		
11/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/652,025

Applicant(s)

NIMS, JERRY C.

Examiner

STEPHEN R. KOZIOL

Art Unit

2624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/15/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

1. In view of the appeal brief filed on 07/15/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Samir A. Ahmed/

Supervisory Patent Examiner, Art Unit 2624.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 5 recites the limitation "generating a first projection of said image of said multi-layered image representing a left eye view and a second projection of said multi-layer image representing a right eye view, said projection based on..." (emphasis added). It is unclear whether "said projection" refers to the first projection or the second projection. Please clarify.

4. Claim 5 recites the limitation "said multiplayer image" in the "generating at least a first frame and a second frame..." limitation. There is insufficient antecedent basis for "said multiplayer image" in Claim 5 ("said multiplayer image" is the first time a "multiplayer" image is introduced). If "said multiplayer image" is intended to refer the multi-layer image recited in claim 5, then the following amendment would overcome the present rejection:

"generating at least a first frame and a second frame, said first frame representing a projection of said multi-layer ~~multiplayer~~ image onto a first left eye image plane and said second frame representing a projection of said multi-layer ~~multiplayer~~ image onto a first right eye image plane;"

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. § 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. § 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (See *In re Bilski*, ___ F.3d ___ (Fed. Cir. 2008) (*en banc*) also, see the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled Clarification of “Processes”¹ under 35 U.S.C. § 101, elucidating the Office's understanding and application of the “tied-to or transformation” criteria). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

In order to be “tied-to” another statutory category, structure associated with another statutory category must be positively recited in a step or steps significant to the basic inventive concept. See *In re Bilski*, ___ F.3d ___ (Fed. Cir. 2008) (*en banc*) “The Supreme Court ... has enunciated a definitive test to determine whether a process claim is tailored narrowly enough to”

¹ Link to the memo:

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_101_05_15_2008.pdf
or, from uspto.gov: Policy and Law→Patents→Memorandum to the Examining Corps→Clarification of “Processes” under 35 U.S.C. § 101.

“encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” Id. at 10-11 (emphasis added). Structure in statements of intended use or purpose, whether in the claim or preamble, is not sufficient. “[T]he involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.” Id. at 24.

- Structure recited as part of insignificant pre and post solution activity is not sufficient (i.e. the structure must be significant to the basic inventive concept).
- The other statutory category must be “positively” recited in the claim, not implied by the claim. Structure will not be read from the specification into the claim.

Instant independent claims 1 and 5 (and dependent claim 2-4) are “processes” that fail to recite structure that is significant to the basic inventive concept. Hence, claims 1-5 do not meet the “tied-to” criteria requiring structure to be positively recited (not implied) in the process claim. One way to overcome the present 35 U.S.C. § 101 rejection may be to amend independent claims 1 and 5 to positively recite the “particular machine” used to perform the steps of the process. It is noted that claim 4 does recite use of “a digital computer.” Whether or not the limitations of “inputting to a digital computer a 2D file; displaying a 2D file; and printing said interlaced image file on said micro optical medium” positively recite the use of a particular machine, these limitations are part of insignificant extra-solution activity, and are not significant to the central purpose of the claimed process (i.e. claims 1 and 5 are silent on whether or not the “digital computer” or any other potentially particular machine performs or executes any of the remaining

steps of the method critical to the central purpose of the claimed method) and so cannot be used to establish a “tie” to a particular machine in another statutory category. If, in fact, the “digital computer” is the particular machine which executes steps of the method critical to the central purpose of the claimed method, the present 35 U.S.C. § 101 rejections could be overcome by an amendment positively reciting the digital computer's role in executing the method steps critical to the central purpose of the claimed method. (See *Gottschalk, Comr. Pats. v. Benson et al.*, 175 USPQ 673 (1972), suggesting that a “digital computer” executing the steps of a method may qualify as patentable subject matter under 35 U.S.C. § 101.)

The basic idea is that a process must be tied to something real (i.e., another statutory category), and not be an idea or concept separated from or floating above or apart from real things. According to the Office's present understanding, any “process” claim must show a “tie” to a another statutory category (e.g. through a particular machine).

For a more detailed explanation of this or other Office policy, Applicants may refer to the Office of Patent Legal Administration (OPLA):

- (571) 272-7701 – General patent examination legal and policy guidance

Allowable Subject Matter

6. Claims 1-5 would be allowable if amended to overcome the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112 ¶2 as set forth herein. The prior art of record, alone or in combination, fails to fairly teach or suggest the method for converting a 2D image to a 3D image further comprising the limitations of receiving a user-entered depth command that assigns a first depth value to a first area, and assigns a second depth value to a second area, and generating a parallax

image based on the first and second depth values as required by instant independent claims 1 and 5.

Contact

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Koziol whose telephone number is (571) 270-1844. The examiner can normally be reached on Monday - Friday 9:00 - 5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached at (571) 272-7413 . Customer Service can be reached at (571) 272-2600. The fax number for the organization where this application or proceeding is assigned is (571) 273-7332.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/10/2008
/srk/

/Samir A. Ahmed/

Supervisory Patent Examiner, Art Unit 2624